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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,503	01/31/2002	Anthony Marfat	PC11896A	7832

23913 7590 11/29/2002

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EXAMINER

DESAI, RITA J

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 11/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/066,503		Applicant(s) MARFAT ET AL.	
	Examiner RITA J. DESAI		Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on ____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) 2,3,5,29 and 30 is/are withdrawn from consideration.

5) ☐ Claim(s) ____ is/are allowed.

6) ☒ Claim(s) 1,4 and 6-28 is/are rejected.

7) ☐ Claim(s) ____ is/are objected to.

8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.

4) ☐ Interview Summary (PTO-413) Paper No(s). ____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

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DETAILED ACTION

Priority

The priority to the provisional application # 60/265304 filed 1/31/2001 has been acknowledged.

Election/Restrictions

Claims pending 1-30.

DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-28 in part, drawn to compounds, pharmaceutical compositions and method of treating wherein Y is $=CRa'$, j is 1, W1 and w2 are O or S(O)t, J1 and J2 are unsaturated 6 membered hydrocarbon ring, and R5 and R6 together forms a five membered hetero ring, D is a non- hetero ring containing group, R7 is non-hetero ring containing group, RA and RB do not together form a ring, drawn to allergic and respiratory diseases classified in class 546, 514, subclass 284.1, 270.1, 271.7, 273.1, 275.7, 281.1, and 338. a species of example 8(5.5.8) was elected and the examiner has used this to form the above group based on the knowledge of legal and chemical equivalence.
- II. Claims 29 and 30, drawn to method of treating and complex compositions classified in class 514 and 424 and various subclasses.
- III. Claims 1-28 in part, drawn to a different combinations of the variables, given in group I, classified in various classes, and subclass. A further election of a single disclosed species is required.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions I and III are drawn to compounds with a different core and hence different bonding and properties.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II or III, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Robert Ronau on 11/21/2002 a provisional election was made with traverse to prosecute the invention of group I, claims 1-28 in part, drawn to compounds, pharmaceutical compositions and method of treating wherein Y is $=C(Ra')$, j is 1, W1 and w2 are O or S(O)_t, J1 and J2 are saturated 6 membered hydrocarbon ring, and R5 and R6 together forms a six membered hetero ring, D is a non- hetero ring containing group, R7 is non- hetero ring containing group, RA and RB do not together form a ring, drawn to allergic and respiratory diseases classified in class 546, 514, subclass 284.1, 270.1,

271.7, 273.1, 275.7, 281.1, and 338. a species of example 8(5.5.8) was elected and the examiner has used this to form the above group based on the knowledge of legal and chemical equivalence.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 29, 30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

If applicant's traverse on the grounds that the inventions are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the groups to be obvious variants or clearly admit on the record that this is the case. In either instance if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 USC 103 of the other invention.

Applicants are required to amend the claims to the elected group in their response. Applicants preserve their right to file a divisional on the canceled non-elected subject matter, without prejudice in due course.

Specification

Applicant is reminded of the proper content of an abstract of the disclosure.

The abstract of the disclosure is objected to because it does not clearly disclose the elected group. A new abstract clearly drawn to only the elected claims, on a separate page, not more than 250 words including the structure is required. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claims 6 and 8 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Since the elected group is drawn to the J1 and J2 being a phenyl group the claims when amended would be duplicates of claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

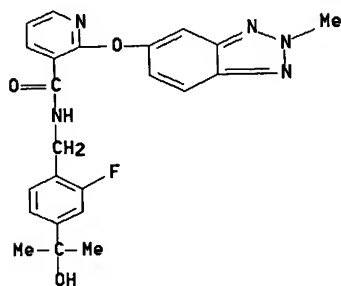
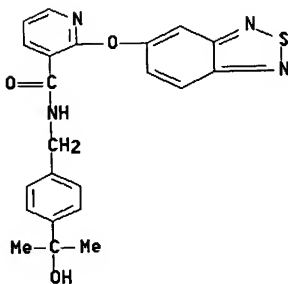
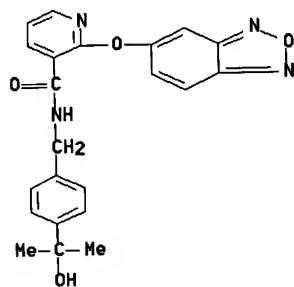
- (e) the invention was described in-
 - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
 - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

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Claims 1,4, 7-28 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by WO 01/57036 (102e date 1/31/2000), Marfat et al. (same assignee different inventors)

The '036 document clearly discloses all the benzo fused heterocyclic nicotamide compounds of the instant invention.

See examples 1,2,4-12,15,17, 18-21 in the reference.



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Prior Art of record:-

WO 01/57025 Chambers et al teaches the methylene dioxy het group but the compounds are drawn to the non -elected group wherein Y is an N.

Marfat et al WO 98/45268 teaches similar compounds but the J2 group is different.

Conclusion

None of the claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RITA J. DESAI whose telephone number is 703-305-1868. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



R.D.

November 25, 2002